

## **REMARKS/ARGUMENTS**

The Applicant acknowledges, with thanks, the office action dated December 2, 2008. Claims 1-4, 6, 9-23, 30-36, and 41-43 are currently pending, with claims 16-19 and 31-33 standing withdrawn. Claims 9, 14, 15, 21, 23, 30, and 42 have been canceled. Claims 1, 20, 22, and 34 have been amended. No new matter has been added in accordance with the amendments made herein.

### **Non-Art Matters**

Claims 20-23, 30, 34, 42, and 43 were rejected to under 35 U.S.C. §112, first paragraph, as failing to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with the claims. Claims 21, 23, 30, and 42 have been canceled. Claims 20, 22, and 34 have been amended to reflect that the mammalian donor and mammalian recipient cells are of the same species. The pending claims have also reflect the activation component required by the Examiner. In view of the amendments made thereto, withdrawal and reconsideration of this rejection is respectfully submitted.

Claims 14 and 15 were also rejected under the second paragraph of 35 U.S.C. § 112 as being confusing. Claims 14 and 15 have been canceled. Applicant respectfully requests withdrawal and reconsideration of this rejection.

Claims 1, 9, 14, and 15 were rejected to under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 9, 14, and 15 have been canceled. Claim 1 has been amended, whereby Applicant respectfully requests withdrawal and reconsideration of this rejection.

### **Art Matters**

Claims 1-3, 6, 10-13, 21, 30, 34, 36, and 41-43 have been rejected as being unpatentable over Czolowska et al. (1984) J. Cell Sci., Vol. 69, pp. 19-34 (*hereinafter*, “Czolowska”) in view of Wakayama et al. (1998) Nature, Vol. 394, pp. 369-374 (*hereinafter*, “Wakayama”). Claims

21 and 30 have been canceled. Independent claims 1 and 34 have been amended. Withdrawal and reconsideration of this rejection is requested for the reasons that will now be set forth.

As currently amended, independent claims 1 and 34 are directed to donor and recipient mammalian cells of the same species. Czolowska, in contrast to the present claims, combines human and mouse cells. Applicant respectfully submits that nothing in Czolowska suggests that the donor and recipient both be from the same species. Furthermore, Czolowska teaches the fusion of a human cell and mouse cell, and not the introduction of a nucleus from a donor cell into a recipient cell as set forth in the instant claims. Wakayama, in contrast to the instant claims, teaches nuclear transfer in which a donor cell is introduced into a recipient which has already been enucleated, and not the removal or destruction of the recipient cell's nucleus, as set forth in the subject claims. Thus, Applicant respectfully submits that nothing in Czolowska, alone or in combination with Wakayama teaches independent claims 1, 20, and 34 as currently amended. Claims 2-3, 6, 10-13, 36, and 41 depend directly from claim 1 and thus contain each and every element of claim 1. Therefore, claims 2-3, 6, 10-13, 36, and 41 are not obvious in view of either Czolowska alone or in combination with Wakayama. Claim 43 depends directly from claim 34 and thus contains each and every element of claim 34. Therefore, claim 43 is not obvious in view of either Czolowska alone or in combination with Wakayama.

Claims 20, 22, and 23 were rejected to under 35 U.S.C. §103(a) as being unpatentable over Czolowska, in view of Cibelli et al. (1998) Science, vol. 280, pp. 1256-1258 (hereinafter, "Cibelli"). Claim 23 has been canceled, and claim 20 has been amended. Withdrawal and reconsideration of this rejection is requested for the reasons that will now be set forth.

Claim 20 has been amended to reflect that the donor and recipient mammalian cells are of the same species, which is not taught or suggested by any teachings of Czolowska. Furthermore, Czolowska is directed to fusion of cells and fails to teach or suggest the introduction of a nucleus from a donor cell into a recipient cell, with the removal or destruction of the recipient nucleus, as set forth in claim 20. In addition, Cibelli is directed to nuclear transfer in which a donor cell is introduced into an enucleated recipient cell. In contrast, the subject claim requires the removal or destruction of the mammalian recipient cell nucleus. Thus, Applicant respectfully submits that nothing in Czolowska, alone or in combination with Cibelli, teaches or suggest the method as set forth in amended claim 20. Claim 22 depends directly from claim 20, and as such includes

each and every limitation of claim 20. Therefore, claim 22 is not obvious in view of either Czolowska alone or in combination with Cibelli.

Claims 1, 9, 12-15, and 35 were rejected under 35 U.S.C. §103(a) as being unpatentable over Czolowska in view of U.S. Patent No. 5,945,577 to Stice (hereinafter, "Stice"). Claims 9 and 14-15 have been canceled, and claim 1 has been amended. Withdrawal and reconsideration of this rejection is requested for the reasons set forth below.

As previously addressed, Czolowska is directed to the fusing of a human and mouse cell, and not the introduction of a nucleus from a donor to a recipient of the same species. The aforementioned failings of Czolowska are not rectified by any teachings of Stice. Stice teaches nuclear transfer in which donor material is introduced into an enucleated recipient cell. Applicant respectfully submits that such a transfer does not teach or suggest the removal or destruction of the mammalian recipient cell nucleus. Thus, the Applicant respectfully argues that nothing in Czolowska, alone or in combination with Stice, teaches or suggests the invention as set forth in claim 1. Claims 12-13 and 35 depend directly from claim 1 and thus include each and every element of claim 1. Therefore, for the reasons set forth above with respect to claim 1, Czolowska, alone or in combination with Stice, fails to teach or suggest claims 12-13 and 35.

Claims 1 and 4 were rejected under 35 U.S.C. §103(a) as being unpatentable over Matveeva et al. (1998) Molec. Reprod. Devel., Vol. 50, pp. 128-138 (hereinafter, "Matveeva"), Tada et al. (1997) EMBO J., Vol. 16, pp. 6510-6520 (hereinafter, "Tada"), or Rousset et al. (1983) Devel. Biol., Vol. 96, pp. 331-336 (hereinafter, "Rousset"), in view of Wakayama. Claim 4 has been canceled, and claim 1 has been amended. Withdrawal and reconsideration of this rejection is requested for the reasons set forth below.

Independent claim 1, as currently amended, includes the elements of introducing a nucleus from a donor cell into a recipient cell of the same species, and not the cellular fusion taught by Matveeva. Applicant further submits that the failings of Matveeva are not cured by any teachings of Tada, Rousset, and/or Wakayama. Tada, Rousset, and Wakayama each teach the insertion of a nucleus into an enucleated recipient cell. Nothing in Tada, Rousset, or Wakayama, alone or in combination with Matveeva, teach or suggest the invention as set forth in currently amended claim 1.

In this amendment, Applicant has amended claims 1, 20, 22, and 34, and canceled claims 9, 14, 15, 21, 23, 30, and 42 from further consideration in this application. Applicant is not conceding that the subject matter encompassed by any of the aforementioned claims prior to this amendment is not patentable over the art cited by the Examiner. Claims 1, 20, 22, and 34 were amended and claims 9, 14, 15, 21, 23, 30, and 42 were canceled in this amendment solely to facilitate expeditious prosecution of the claims remaining in this application. Applicant respectfully reserves the right to pursue claims, including the subject matter encompassed by any claim presented prior to this amendment and additional claims in one or more continuing applications. No subject matter is disclaimed or surrendered pursuant to the instant amendment.

### **CONCLUSION**

In accordance with the afore-noted amendments and comments, it is submitted that all claims are patentably distinct over the art, and in condition for allowance thereover. An early allowance of all claims is respectfully requested.

If there are any fees necessitated by the foregoing communication, the Commissioner is hereby authorized to charge such fees to our Deposit Account No. 50-0902, referencing our Docket No. 78870/00004.

Respectfully submitted,

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